

REMARKS

This Amendment is filed in response to the final Office Action dated December 12, 2007, and is respectfully submitted to be fully responsive to the rejections raised therein. Accordingly, favorable reconsideration on the merits and allowance are respectfully requested.

In the present Amendment, claim 6 has been amended by changing “isocyanurate” to “polyisocyanate” obtained by the methods described in the present specification on pages 12 and 13; and by inserting a Markush group for the carboxyl group (a3). Support for the amendment can be found on page 11, paragraph [0030], for example.

Claim 11 has been amended by changing “isocyanurate” to “polyisocyanate”. Support for the amendments can be found, e.g., in paragraph [0033] bridging pages 12 and 13 in the specification.

Claims 1-5 and 10 are canceled.

No new matter has been added. Entry of the Amendment is respectfully submitted to be proper. Upon entry of the Amendment, claims 6-9 and 11 will be all the claims pending in the application.

I. Response to Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 6-9 and 11 are rejected under 35 U.S.C. § 112, first paragraph. Particularly, the Examiner indicates at paragraph 2A on page 2 of the Office Action, that the amendments to claims 6 and 11 reciting “isocyanurate” raise new matter under 35 U.S.C. § 112, first paragraph because, the original claims require a polyisocyanate.

Applicants traverse and respectfully request withdrawal of the rejection in view of the amendment and the following remarks.

Applicants submit that isocyanurate is derived from isocyanates, and that an isocyanurate derived from diisocyanates contains isocyanate groups place of the hydrogen atoms of the cyclic nitrogen atom. Thus, diisocyanate-derived isocyanurate is a polyisocyanate.

Nevertheless, without conceding to the merits of the rejection, claims 6 and 11 have been amended by replacing “isocyanurate” with “polyisocyanate”. The claim has been further amended to recite that the polyisocyanate is obtained by a method selected from the group consisting of: (1) adding an isocyanuration catalyst to an aliphatic isocyanate and/or alicyclic isocyanate; and (2) reacting an aliphatic isocyanate and/or an alicyclic isocyanate with a low molecular weight polyol. Accordingly, withdrawal of the rejection is respectfully requested.

II. Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 6-9 and 11 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Referring to paragraph 2B on page 2 of the Office Action, the Examiner asserts that notwithstanding Applicants’ description in paragraph [0030] in the present specification, there is assertedly no support in the original specification for the recitation: “wherein the glycol containing a carboxyl group (a3) has a number average molecular weight of 162.18 or lower”.

Applicants traverse and request reconsideration in view of the following remarks.

The standard for determining compliance with the written description requirement is whether the description clearly allows persons of ordinary skill in the art to recognize that he or she invented what was claimed.¹ In this case, Applicants have possession of the claimed

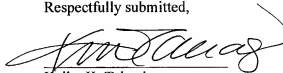
¹ M.P.E.P. 2163.02 (Rev. 6, Sept. 2007) (*citing In re Gosteli*, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)).

invention as indicated by the chemical compounds listed in the examples. Specifically, paragraph [0030] of the specification states: “[e]xamples of low molecular weight glycol containing a carboxy group (a3) used in the invention include 2,2-dimethylolpropionic acid, 2,2-dimethylolbutanoic acid, 2,2-dimethylolbutyric acid and 2,2-dimethylolvaleric acid.” These compounds have molecular weights between 134.13 (2,2-dimethylolpropionic acid) and 162.18 (2,2-dimethylolvaleric acid). Thus, a person of ordinary skill in the art would recognize that the inventors were in possession of the invention as claimed. Furthermore, Applicants have amended claim 6 by deleting the phrase “has a number average molecular weight of 162.18 or lower” and by inserting the ---2,2-dimethylolpropionic acid, 2,2-dimethylolbutanoic acid, 2,2-dimethylolbutyric acid and 2,2-dimethylolvaleric acid--- as a Markush group for the glycol containing a carboxyl group (a3) for further clarity.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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